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Dwight Marcus

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EXAMINER

BEKERMANN, MICHAEL

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/896,838 | Applicant(s) MARCUS, DWIGHT | |
| | Examiner MICHAEL BEKERMAN | Art Unit 3622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 149-165 is/are pending in the application.
- 4a) Of the above claim(s) 158-162 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 149-157 and 163-165 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/1/2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1, 149-157, and 163-165 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, this claim recites the limitation “the signifiers being an orthographic appearance of a word apart from the meaning of the word”. Nowhere in the specification is the “meaning” or “topic” of words discussed. The Merriam Webster

definition of “signifier” is “a symbol, sound, or image (as a word) that represents an underlying concept or meaning”. Since the common interpretation of signifier is that it represents an underlying concept or meaning, and since Applicant has never specified otherwise in the specification, to state otherwise is considered new matter. Claims 149 and 150 inherit this rejection through dependency from claim 1.

Regarding claim 1, this claim recites the limitation “providing the incentive...only if the indication has been determined to demonstrate the sufficient knowledge”. This limitation is meant to exclude an incentive of any kind as being offered unless sufficient knowledge is indicated, and applicant's specification has no support for such an exclusion. Rather, the specification is directed primarily towards giving an incentive should a user display sufficient knowledge, but never specifies that the incentive is specifically not obtainable should sufficient knowledge not be displayed. Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. See MPEP 2173.05(i). Claims 149 and 150 inherit this rejection through dependency from claim 1.

Regarding claim 149, this claim recites the limitation “said signifier use instruction comprises a conversion code”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding the conversion code) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on

page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter. Claim 150 inherits this rejection through dependency from claim 149.

Regarding claim 150, this claim recites the limitation “said another type of information comprises contact information for claiming the incentive”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding contact information to claim an incentive) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 151, this claim recites the limitation “the instructions pertain to extracting information independent of a meaning of the text form information in which the text form signifiers are inserted”. Nowhere in the specification is the “meaning” or “topic” of words or information discussed. Since Applicant has never addressed the meaning or topic of information or how it pertains to such instructions in the

specification, this is considered new matter. Claims 152-157 and 163-165 inherit this rejection through dependency from claim 151.

Regarding claim 153, this claim recites the limitation “wherein the text form information comprises instructional material...making available support associated with a product or service....customer support is made available...in a second manner”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding instructional material and customer support) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter. Claims 154 and 155 inherit this rejection through dependency from claim 153.

Regarding claim 154, this claim recites the limitation “the first manner is a lower cost than the second manner”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding a lower cost second manner) was never disclosed as being usable with the information from the parent

independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 155, this claim recites the limitation “disclosing a toll-free customer support number”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding a toll-free customer support number) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 156, this claim recites the limitation “the text form information comprises medical instructions and access to medication is provided”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding medical instructions or access to medicine) was never

disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 163, this claim recites the limitation “the text form information comprises an instruction manual”. However, the specification indicates approximately 145 iterations of the language “in one embodiment” or “in another embodiment”. These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding an instruction manual) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

Regarding claim 164, this claim recites the limitation “providing an article...having a substrate having multiple layers having printed information thereon, the signifiers enabling the information consumer to engage in the removal, application, and/or repositioning of elements on the article, to reveal information”. However, the specification indicates approximately 145 iterations of the language “in one

embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding repositioning of elements) was never disclosed as being usable with the information from the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 2 embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter. Claim 165 inherits this rejection through dependency from claim 164.

Regarding claim 165, this claim recites the limitation "the text form information comprises instructional material relating to a product or service, and the revealed information is a toll-free customer support telephone number". However, the specification indicates approximately 145 iterations of the language "in one embodiment" or "in another embodiment". These are all considered to be separate embodiments, and these embodiments are not disclosed as being usable together. The language in this claim (regarding instructional material and a toll-free number) was never disclosed as being usable with the information from claim 164 (regarding repositioning of elements) or the parent independent claim (which Applicant alleges support for on page 22, lines 4-19 of the specification, and while that section is not believed to have support for all the limitations of the claim, it is clear from the arguments that this is the embodiment which Applicant is attempting to claim). Since these 3

embodiments are not disclosed as usable together, the combination of such elements is considered to be new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 164 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claim 164, this claim recites the limitation "and/or". It is unclear whether this limitation should be interpreted as "and", "or", both, or neither.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 1, 149-157, 164, and 165 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Regarding claims 1, 149-157, 164, and 165, based on Supreme Court precedent, a method/process claim must **(1)** be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or **(2)** transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v.*

Benson, 409 U.S. 63, 71 (1972)). A method or process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1 and 148-150 are rejected under 35 U.S.C. 102(b) as being anticipated by McGregor (U.S. Patent No. 5,236,200).** McGregor teaches a method of providing an incentive that includes all of the limitations recited in the above claims.

Regarding claim 1, McGregor teaches providing information to an information consumer (treasure hunt game card) (Figure 1) with a plurality of signifiers enclosed therein (appearance of the words that form clues) (Column 1, Lines 59-63). A signifier use instruction is inherent when the treasure hunt game is provided (follow the clues to get to the treasure). Should the information consumer display sufficient knowledge of the appearance of the words, to decipher the clues, they will receive an incentive (the

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treasure/gift) (Column 1, Lines 59-63). The claim language is very broad and does not specify who performs the steps of the method. Therefore, the step of receiving could be performed by an onlooker or the consumer himself (both of which would be inherent). A step of determining could also be done by an onlooker or the consumer himself (if the consumer finds the prize, this proves to the consumer or an onlooker that the consumer knows how to read the clues). The consumer is provided with the incentive only if sufficient knowledge of the appearance of the signifiers is demonstrated. Otherwise, the prize remains unfound.

Regarding claims 149 and 150, McGregor teaches anagrams and puzzles as clues (Column 3, Lines 14-22). This represents a conversion code for conversion of the clue to another type of information that may be used to locate and claim the incentive (contact information).

6. **Claims 151-155 and 163-165 are rejected under 35 U.S.C. 102(a) as being anticipated by Sony (Owner's Manual, Sony Video Cassette Recorder Model SLV-662HF, 1999).** Sony teaches providing access to a toll-free phone number that includes all of the limitations recited in the above claims.

Regarding claims 151-155, 163, and 165, Sony teaches providing text form information (the manual itself) having text form signifiers enclosed within (the toll-free phone number at the bottom of the last page). If the consumer reviews the Sony manual and finds the phone number, then the customer is rewarded with toll-free customer service. However, if the customer does not sufficiently review the manual to

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find the toll-free phone number, they will inherently need to seek other options for customer service, such as driving to a retail establishment (which would inherently cost more than a toll-free number would). The numbers in the phone number are each in a different separate location than the other numbers (in 80, the 8 is beside the 0, and this reads on plural separate locations and being located “throughout” the manual). The signifier numbers are the same font as all the information around it, so they are typeset consistently with the text form information. There are signifier instructions included as well (“If you have any questions about this product, you may call”, bottom of last page). The meaning of the text form information in which the signifiers are inserted is “operation of a VCR”. The signifier instructions do not teach one how to use a VCR, and therefore the instructions are independent of the meaning of the text form information.

Regarding claim 164, the Sony document in and of itself represents an article on which signifiers were recorded, the article having multiple layers (pages) with information printed thereon, and the consumer is enabled to reposition the pages to reveal information. As the signifiers do not prevent the flipping of pages, this enables the user to flip pages.

7. Claims 151, 156, and 157 are rejected under 35 U.S.C. 102(b) as being anticipated by Benson (U.S. Patent No. 3,926,325). Benson teaches a method of providing access to medication that includes all of the limitations recited in the above claims.

Regarding claims 151, 156, and 157, Benson teaches providing information on the side of bottles (provided text form information) including instructions about how to open the child-proof cap (text form signifiers) (Figure 3, Column 1, Lines 26-37). The bottle of Benson is meant for medicine (Column 2, Lines 39-41), and thus the text form provided information are medical instructions. Should the consumer display sufficient knowledge of the signifiers, they may use the signifiers (instructions) to gain access to the medication within the bottle. The claim language is very broad and does not specify who performs the steps of the method. Therefore, the step of receiving could be performed by an onlooker or the consumer himself (both of which would be inherent). A step of verifying could also be done by an onlooker or the consumer himself (if the consumer is taking the medicine, this proves to the consumer or an onlooker that the consumer knows how to open the bottle). Each letter of the directions on the bottle of Benson are in a different separate location than the other letters (in "discard", the "d" is beside the "i", and this reads on plural separate locations). The signifier letters are the same font as all the information around it, so they are typeset consistently with the text form information. There are signifier instructions included as well ("For general use" or "For child-protective use", Figure 3). The meaning of the text form information in which the signifiers are inserted is "identification of the device on the upper portion of the bottle" (Figure 3, see "Reversible – Stopper/Cap"). The signifier instructions have a different meaning than mere identification of the device on the upper portion of the bottle, and therefore the instructions are independent of the meaning of the text form information.

Response to Arguments

8. **Applicant argues** that the interpretation of "the consumer himself could receive an indication from himself is not a reasonable interpretation of the claim language" and the interpretation of "the determining could be performed by the information consumer similarly is not a reasonable interpretation of the claim language". However, Applicant's claims do not specify who is to perform such steps, and therefore the interpretation is open to the possibility of anyone performing any and all steps. The claim language does not require that a consumer not perform such steps (nor would such a limitation be supported by the specification), and as such this interpretation is well within the boundaries of a broadest reasonable interpretation.

9. **Applicant argues** "The Examiner's statement that McGregor inherently recites receiving an indication by an onlooker is contrary to the process of McGregor". However, an onlooker watching someone who is using the invention of McGregor would be able to readily tell that the user was able to understand the clues. Thus, that onlooker would receive an indication from the user. Applicant's claims do not specify who is to perform such steps, and therefore the interpretation is open to the possibility of anyone performing any and all steps. Applicant further argues "there is no step of providing an indication to an onlooker". Applicant's currently claimed invention, however, does not require such a step. There is a step of receiving an indication, not "providing an indication". Therefore, this argument is moot.

10. **Applicant argues** that the instructional messages, anagrams, and puzzles of McGregor don't include signifiers. However, as explained in the rejection above, the appearance of the words that form clues are considered to be signifiers. Therefore, the claim language has indeed been met.

11. **Applicant argues** "the Examiner unreasonably attempts to interpret the step of verifying as performed by the information consumer. As the verification is based on the indication received from the information consumer, the step of verification is necessarily preformed by another". However, Applicant's claims do not specify who is to perform such steps, and therefore the interpretation is open to the possibility of anyone performing any and all steps. The claim language does not require that a consumer not perform such steps (nor would such a limitation be supported by the specification), and as such this interpretation is well within the boundaries of a broadest reasonable interpretation.

12. **Applicant argues** "The Examiner's statement that Benson inherently provides an onlooker is simply incorrect. Under the Examiner's interpretation, Benson would teach that opening a bottle becomes a two-person operation, requiring an operator and a verifier". However, nowhere in the rejection did Examiner suggest that an operator and a verifier were required to open a bottle. An onlooker watching someone who is using the invention of Benson would be able to readily tell that the user was able to understand the instructions. Thus, that onlooker would receive an indication from the user. Applicant's claims do not specify who is to perform such steps, and therefore the interpretation is open to the possibility of anyone performing any and all steps.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMANN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/
Examiner, Art Unit 3622